



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 09/363,413 | 07/29/1999 | ADDISON M. FISCHER | 264-169 | 8101 |
| 23117 | 7590 | 07/24/2006 | EXAMINER | |
| NIXON & VANDERHYE, PC | | | JACKSON, JENISE E | |
| 901 NORTH GLEBE ROAD, 11TH FLOOR | | | | |
| ARLINGTON, VA 22203 | | | ART UNIT | PAPER NUMBER |
| | | | 2131 | |

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/363,413 | FISCHER ET AL. | |
| | Examiner | Art Unit | |
| | Jenise E. Jackson | 2131 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 57-70, 83-89, 101, 103 and 109-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 57-70, 83-89, 109-122, 124-130 is/are rejected.
- 7) Claim(s) 101, 103, 123 and 131 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 57-70, 83-89, 109-122, 124-130 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa et al(6,834,348).
3. As per claims 57, 83, 109, 124, Tagawa et al. discloses a method of transferring authorization to render protected electronic content from a first device(i.e. primary recording medium) to a second device(i.e. secondary recording medium)(see fig. 1, sheet 1, and see associated descriptions(see col. 6, lines 3-10, 17-28), having a device cryptographic key(see), receiving a transfer authorization request having an indicator of the first device(see col. 15, lines 39-60), and indicator of the second device, and an indicator of the protected electronic content (see col. 9, lines 43-63); updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate the second device is authorized to render the protected electronic content based on the received transfer authorization request(see col. 18, lines 53-67, col. 19, lines 1-18); and communicating a transfer authorization response having an indicator of the second device, an indicator of the protected electronic content, and a content cryptographic key for the protected electronic content protect using the device cryptographic key of the second device so that only

the second device may gain access to the content cryptographic key by use of the device cryptographic key of the second device(see col. 9, lines 38-63, col. 19, lines 50-61).

4. As per claims 58, 110, 125, Tagawa discloses wherein the device cryptographic key of the second device is a symmetric key(see col. 23, lines 53-65).

5. As per claims 59, 111, Tagawa discloses wherein the device cryptographic key of the second device is a DES key(see col. 10, lines 36-46).

6. As per claims 60, 112, 126, Tagawa discloses wherein the device cryptographic key of the second device is a public key having a corresponding private key stored with the second device, and protecting the content cryptographic key suing the device cryptographic key of the second device includes protecting the content cryptographic key with the public key such that the second device may use the corresponding private key to gain access to the content cryptographic key(col. 9, lines 38-63, col. 19, lines 50-61).

7. As per claims 61, 113, Tagawa discloses wherein the public key is an RSA public key and the private key is an RSA private key(see col. 19, lines 50-61).

8. As per claims 62, 114, 127, Tagawa discloses wherein the content cryptographic key is a symmetric key, which is used to encrypt the protected electronic content such that only the symmetric key can be used to decrypt the content(see col. 9, lines 38-63, col. 19, lines 50-61).

9. As per claims 63, 115, 128, Tagawa discloses receiving payment authorization information associated with the transfer authorization request, and charging a service fee based on the payment authorization information (see col. 6, lines 16-31).

10. As per claims 64, 116, Tagawa discloses wherein updating the first device history table includes removing a stored indicator of the protected electronic content from the first device history table(see col. 18, lines 53-67, col. 19, lines 1-18).
11. As per claims 65, 117, Tagawa discloses wherein the updating the first device history table includes adding indicia that the protected electronic content is no longer authorized for the first device(see col. 29, lines 40-67, col. 30, lines 1-6).
12. As per claims 66, 118, Tagawa discloses wherein the protected electronic content is audio content(see col. 6, lines 40-53).
13. As per claims 67, 119, Tagawa discloses wherein the protected electronic content is video content(see col. 5, lines 63-67, col. 6, lines 1-2).
14. As per claims 68, 120, Tagawa discloses wherein the protected electronic content is electronic written content(see col. 13, lines 47-52).
15. As per claims 69, 121, 129, Tagawa discloses wherein the indicator of the first device in the transfer authorization request is a unique serial number(see col. 9, lines 43-63, see col. 15, lines 39-60).
16. As per claims 70, 122, 130, Tagawa discloses verifying that the first device is authorized to render the protected electronic content(see col. 6, lines 3-31).
17. Claims 101, 103, 123, and 131, are objected to as being rejected on base claims. The claims are allowable, “wherein the first and second devices are devices which may be inserted into a standard tape player having a plurality of conventional user controls”. The prior art does not teach or suggest two devices, which are inserted into a tape players, which used cryptographic key.

Response to Amendment

18. The Applicant states that the priority date of August 5, 1998 is not the priority date of the reference(6,550,011). Patent 6,550,0111 Sims et al, is a continuation in part to 6,438,235 which has the filing date of August 5, 1998. The Applicant's arguments are persuasive. The Examiner has not relied up 6,550,011 to reject the pending claims above. The Examiner has applied new art. Thus remarks made on Sims 6,550,011 are moot.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E. Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/363,413
Art Unit: 2131

Page 6

jj

July 18, 2006

CHRISTOPHER REVAT
PRIMARY EXAMINER

Cal 7/19/06